REMARKS

In the Office Action dated March 14, 2006, the Examiner rejected claims 28, 29,

31, 32, 34, 35, 37, 38, 40, 42, 44-47, 49, 50, 52, 53, 55, 56, 58, 60, 62, 64-71, 73-81,

and 83-88 under 35 U.S.C. § 101, rejected claims 28-76 and 78-89 under

35 U.S.C. § 102(e) as being anticipated by *Schnier* (U.S. Patent Publication No.

2001/0003825), and rejected claim 77 under 35 U.S.C. 103(a) as unpatentable over

Schnier in view of *Pino* (U.S. Patent No. 5,966,435).

By this amendment, Applicants have amended claims 28, 29, 37, 44, 45, 46, 47,

55, 56, 62, 71, 73, 75, 78, 80, 81, 85, 87, and 89. Based on these amendments and the

following remarks, Applicants respectfully traverse the rejections presented in the Office

Action.

I. The Rejection of Claims 28, 29, 31, 32, 34, 35, 37, 38, 40, 42, 44-47, 49, 50, 52, 53, 55, 56, 58, 60, 62, 64-71, 73-81, and 83-88 under 35 U.S.C. § 101

The Examiner rejected claims 28, 29, 31, 32, 34, 35, 37, 38, 40, 42, 44-47, 49,

50, 52, 53, 55, 56, 58, 60, 62, 64-71, 73-81, and 83-88 under 35 U.S.C. § 101. In

particular, the Examiner asserts "the claimed invention lacks practical application

because applicant merely claims facilitating access" and continues "at best, 'facilitating

access' is the manipulation of abstract ideas" (OA at 2.) Applicants disagree. The

Examiner improperly interprets claim recitations to support the unreasonable position

that "facilitating access" in the context of these claims is the manipulation of abstract

ideas. For example, the Examiner asserts the definition of "facilitate" means to

"promote, aid make easy, expedite." This definition, however, supports the position that

the recitations of these claims have practical application and do not merely manipulate

abstract ideas. For instance, loading executable code to "promote" or "expedite" (i.e., facilitate) access of the one network service is practical and not manipulating an abstract idea. Applicant's specification provides sufficient disclosure of various aspects that illustrate the practical application of the claimed invention. Instead, the Examiner merely concludes the claims lack practical application without establishing in the Office Action how a reasonable interpretation of such terms is considered a manipulation of abstract ideas. Such positions are conjecture and do not meet the standards set forth in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, issued by the U.S. Patent & Trademark Office on October 26, 2005 ("the Interim Guidelines").

Nevertheless, in an effort to expedite prosecution, Applicants have amended claims 28, 44, 46, 55, 62, 71, 78, 81, and 85 to recite "for accessing" rather than "facilitating access." Because these claims and their respective dependent claims are directed towards statutory subject matter, Applicants request the rejection under 35 U.S.C. § 101 be withdrawn.

The Examiner further contends "'data for dynamically loading executable code' lacks a concrete, tangible, and useful result because no positive step related to a real world application is claimed" (OA at 2). Applicants traverse the Examiner's interpretation of this phrase. Contrary to the Examiner's position, Applicants' claims do not simply recite "data for dynamically loading executable code," but instead recite "returning, by the lookup service, a resource locator to the client, the resource locator including data for dynamically loading executable code for accessing the one network service." Accordingly, the Examiner has improperly considered the phrase "data for

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dynamically loading executable code" without considering the phrase in the context of the claim as a whole. The Interim Guidelines indicate that "when evaluating the scope of a claim," the Examiner must consider "every limitation in the claim." *Interim Guidelines* at p. 9. Further, "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." *Id.* In this case, when viewed in light of the surrounding claim language, it is clear that the phrase "data for dynamically loading executable code" is associated with the useful step of "returning ... to the client ... data ... for accessing the one network service." Accordingly, the claimed invention has the utility of returning data to the client through which a "network service" can be accessed, which is a "positive step related to a real world application."

Further, the Examiner's rejection of claims 75 and 80 is legally deficient because these claims do not include recitations the Examiner relies upon to support the rejections under 35 U.S.C. § 101. For example, neither claim includes the phrases "facilitate access" or "data for dynamically loading." The Examiner, however, improperly rejects both of these claims under 35 U.S.C. § 101 for the same reasons set forth above in connection with claim 28, for example. Because the Examiner has not provided a proper grounds to support the rejection of claims 75 and 80, the rejection of these claims are improper and should be withdrawn. Applicants further note that any subsequent Office Action maintaining this rejection would necessarily introduce a "new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" (MPEP § 706.07(a)). As such, should the Examiner maintain the rejection of these claims,

Applicants request that the Examiner provide a non-final Office Action explaining the grounds for the rejection of claims 75 and 80 under 35 U.S.C. § 101.

For the foregoing reasons, Applicants request that the rejection of claims 28, 29, 31, 32, 34, 35, 37, 38, 40, 42, 44-47, 49, 50, 52, 53, 55, 56, 58, 60, 62, 64-71, 73-81, and 83-88, under 35 U.S.C. § 101 are improper and should be withdrawn.

II. The Rejection of Claims 28-76 and 78-89 under 35 U.S.C. § 102(e)

The Examiner asserts *Schnier* discloses each and every recitation of claim 28. In particular, the Examiner asserts that the web server application disclosed in *Schnier* corresponds to the claimed "lookup service," and that the objects on the server in *Schnier* correspond to the to the claimed "network services" (OA at 3.)

Claim 28, however, recites:

> A method in a data processing system for accessing network services associated with a lookup service, comprising the steps of:
> receiving a request from a client by the lookup service for access to one of the network services, the client being remote with respect to the lookup service; and
> returning, by the lookup service, a resource locator to the client, the resource locator including a reference to executable code which can be dynamically loaded by the client for accessing the one network service;
> <u>providing, by a second network service that is initially inaccessible through the lookup service, information to the lookup service to enable the second network service to be accessible through the lookup service</u>.

(emphasis added). Because, as asserted by the Examiner, the objects in *Schnier* correspond to the claimed lookup service, and the web server application corresponds to the claimed network services, *Schnier* cannot disclose the recitations of claim 28.

For example, the server in *Schnier* already contains information for accessing the objects available through the server. In contrast, a second network service that is initially inaccessible through the lookup service, provides information to enable it to be

accessible through the lookup service. Therefore, *Schnier* fails to teach each and every

recitation of claim 28, as asserted by the Examiner. Accordingly, the cited art fails to

support the rejection of this claim under 35 U.S.C. § 102, and thus should be withdrawn

and the claim allowed.

Independent claims 37, 44, 45, 46, 55, 62, 71, 75, 78, 80, 81, 85, and 89 include

recitations similar to that recited in claim 28. As explained, *Schnier* does not support

the rejection of claim 28. Accordingly, the cited art does not support the rejection of

claims 29-61 and 78-89 for at least the same reasons set forth above in connection with

claim 28. Therefore, Applicants request that the rejection of claims 37, 44, 45, 46, 55,

62, 71, 75, 78, 80, 81, 85, and 89 under 35 U.S.C. § 102(e) be withdrawn and the

claims allowed. Additionally, the cited art does not support the rejection of these claims.

Indeed, the Examiner improperly ignores Applicants argument related to some of these

claims. For example, Applicants previously argued in the Amendment filed February 7,

2006,

> *Schnier* also does not teach or suggest returning, by a lookup
> service, executable code to facilitate the access to the one network
> service, <u>wherein the executable code is configured to store data obtained
> from the one network service for subsequent use</u>, as recited in claims 62,
> 71,75, 78, 80, 81, and 85. Therefore, Applicants request that claims 62,
> 71, 75, 78, 80, 81, and 85 be allowed.

(emphasis added). However, in maintaining the rejection of these claims, the Examiner

has not addressed this argument in the outstanding Office Action. MPEP 707.07(f)

states that "where the applicant traverses any rejection, the examiner should, if he or

she repeats the rejection, take note of the applicant's argument and answer the

substance of it." Accordingly, the rejection of at least these claims is legally deficient

because the Examiner has failed to address the recitations of these claims and remarks

pertaining to these recitations. Because *Schnier* does not teach "executable code configured to store data obtained from the one network service for subsequent use," as recited in claims 62, 71,75, 78, 80, 81, and 85, Applicants further request that the rejection under 35 U.S.C. 102(e) of these claims be withdrawn.

Claims 29-36 depend from claim 28, claims 38-43 depend from claim 37, claims 47-54 depend from claim 46, claims 56-61 depend from claim 55, claims 63-70 depend from claim 62, claims 72-74 depend from claim 71, claim 76 depends from claim 75, claim 79 depends from claim 78, claims 82-84 depend from claim 81, and claims 86-88 depend from claim 85. As explained, *Schnier* does not support the rejection of claim 28, 37, 44, 45, 46, 55, 62, 71, 75, 78, 80, 81, 85, and 89. Accordingly, the cited art does not support the rejection of their respective dependent claims for at least the same reasons set forth above in connection with the above listed independent claims . Therefore, Applicants request that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Further, the cited art does not support the rejection of these claims and the Examiner has improperly failed to address the recitations of some of these claims. For example, claims 34, 35, 42, 52, 53, 60, 69, 74, and 88 each recites a "smart proxy." However, the Examiner has not identified how any element in *Schnier* corresponds to a "smart proxy." Instead, the Examiner implies the specification cannot be used to interpret the term recited in the claims. While the Examiner is correct that the USPTO is not required to interpret claim terms in the same sense as the Courts, "claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'" MPEP 2111.01(I).

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As discussed on p. 30 of the specification, a "smart proxy" is "code within which a stub is embedded, helps the client more efficiently implement the stub and the method to be remotely invoked." *Schnier* simply does not teach such a smart proxy.

Moreover, claim 70 recites "returning attributes associated with each stub." The Examiner has not addressed this recitation of claim 70. Accordingly, the rejection of at least this claim is also legally deficient because the Examiner has failed to establish a *prima facie* case of anticipation, which requires a reference to disclose "each and every element set forth in the claim" (MPEP § 2131). Because the Examiner has not demonstrated nor even alleged that *Schnier* discloses "returning attributes associated with each stub," the rejection with respect to claim 70 is improper and should be withdrawn.

II. The Rejection of Claim 77 under 35 U.S.C. § 103(a)

Claim 77 depends from claim 75. As explained, *Schnier* fails to teach or suggest providing information to the lookup service so that a second network service is accessible through the lookup service, as recited in claim 77. *Pino* also fails to teach or suggest this feature. Instead, *Pino* discloses a "switch service management system architecture" (*Pino* col. 2, lines 15-16). Although *Pino* may disclose a system that provides a null value if "no service is found from any provider," *Pino* does not teach or suggest a second network service that provides information, as recited in claim 77.

Because the cited art, alone or in combination, fail to teach or suggest each and every claim element recited by claim 77, the Examiner has not established a *prima facie* case of obviousness in the rejection of claim 77. Applicants therefore respectfully

request the Examiner to withdraw the rejection of this claim 77 under 35 U.S.C. §

103(a).

III. Conclusion

In view of the foregoing remarks, Applicants submit that claims 28-89 are neither

anticipated or obvious in view of the cited art. Applicants therefore request

reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 13, 2006   By: _____

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